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10/806,044	03/22/2004	David J. Thomsen	333628003US1	9996
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PERKINS COIE LLP PATENT-SEA P.O. BOX 1247 SEATTLE, WA 98111-1247			EXAMINER DAYE, CHELCIE L	
			ART UNIT 2161	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

ED

Office Action Summary	Application No. 10/806,044	Applicant(s) THOMSEN, DAVID J.	
	Examiner Chelcie Daye	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2007.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3, 10-12 and 30-35 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 3, 10-12, and 30-35 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is issued in response to applicant's amendment filed July 06, 2007.
2. Claims 3,10-12, and 30-35 are presented. Claims 30-35 are added and claims 1-2,4-9, and 13-29 are cancelled.
3. Claims 3,10-12, and 30-35 are pending.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 3 and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, newly amended claims 3 recites the limitations, "wherein the questionnaire form does not specify a current or anticipated job opening" and "non-economic data measure information", which are not supported within the specification and is deemed as new matter. To begin, the examiner is unclear as to why the questionnaire form is not able to contain a current or anticipated job opening. Further, what contributed information is the user inputting into the questionnaire form if the form does not allow for such detailed information. Lastly, it is unclear if the questionnaire

form is acceptable for other jobs/occupations that do not have current or anticipated job openings. Also, with reference to the 'non-economic' data measure, the examiner does not know how to ascertain a degree of measure for such a feature and the applicant's specification does not provide any description for further knowledge. As such, newly amended claim 10 is rejected under the same premise as above. There is a multitude of uncertainty within the claim language with which the description does not provide an understanding for, and therefore, in order to further prosecution the claims will be given their broadest reasonable interpretation.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claims 3 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, newly amended claims 3 and 10 are rejected under 35 U.S.C. 112, second paragraph, for having negative limitations, which are not clearly pointed out within the description. In particular, claim 3 recites, "wherein the questionnaire form does not specify a current or anticipated job opening", and claim 10 recites, "wherein the questionnaire is not configured for specifying job opening information". The current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C.

112, second paragraph. Some older cases were critical of negative limitations because they tended to define the invention in terms of what it was not, rather than pointing out the invention. Thus, the court observed that the limitation "R is an alkenyl radical other than 2-butenyl and 2,4-pentadienyl" was a negative limitation that rendered the claim indefinite because it was an attempt to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent. *In re Schechter*, 205 F.2d 185, 98 USPQ 144 (CCPA 1953). A claim which recited the limitation "said homopolymer being free from the proteins, soaps, resins, and sugars present in natural Hevea rubber" in order to exclude the characteristics of the prior art product, was considered definite because each recited limitation was definite. *In re Wakefield*, 422 F.2d 897, 899, 904, 164 USPQ 636, 638, 641 (CCPA 1970). In addition, the court found that the negative limitation "incapable of forming a dye with said oxidized developing agent" was definite because the boundaries of the patent protection sought were clear. *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971). Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation, which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112,

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first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a prima facie case for lack of descriptive support. Ex parte Parks, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention. A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form. Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3,10-12, and 30-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pullen (US Patent Application No. 20040064390) filed September 26, 2002, in view of Kauderer (US Patent Application No. 20040172311) filed February 23, 2003, and further in view of "O*NET 98 Data Dictionary", Release 1.0, referred to hereinafter as 'ONET'.

Regarding Claim 3, Pullen discloses a method for providing and collecting information associated with a collection of occupational information, the method comprising:

providing a publicly available web site for users of occupational information ([0030], lines 1-13, Pullen)¹, wherein the publicly available web site allows the users of occupational information to access information associated with the collection of occupational information ([0031], Pullen) and to contribute information used to update the collection of occupational information ([0033], Pullen)²;

providing access to information recently contributed via the publicly available web site ([0040], Pullen), wherein the recently contributed information includes information contributed using questionnaire forms accessible from the publicly available web site ([0034], Pullen)³. While it is inherently clear that Pullen discloses the steps taken to

¹ Examiner Notes: The occupational information is represented by wages and benefits information for a company.

² Examiner Notes: The option of submitting data into a survey corresponds to the contributed information. Also, the "Sea Sand Resort" is the selected information to be updated.

³ Examiner Notes: The survey represents the questionnaire form.

update occupational information, which therefore warrants the step of updating, the actual step of updating is not explicitly mentioned. As such, Kauderer discloses updating the collection of occupational information based on receiving a submission of a questionnaire form accessed from the publicly available web site and at least partially completed, wherein the questionnaire form does not specify a current or anticipated job opening ([0029], lines 22-24, Kauderer)⁴. Pullen and Kauderer are analogous art because they are from the same field of endeavor of web-based information services for companies. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Kauderer's teachings into the Pullen system. A skilled artisan would have been motivated to combine as suggested by Kauderer at paragraph [0004], in order to provide a system for creating and administering a survey. This would be beneficial to the system for evaluation of the activities or tasks within a company and to provide greater flexibility for the information. As such, updating the occupational information provide for a greater flexibility in analyzing the data and generating the needed information. However, the combination of Pullen and Kauderer, are silent with respect to including occupational titles and data measures for each of the occupational titles in the collection and wherein the updating includes either (a) adding a new occupational title and associated non-economic data measure information to the collection of occupational information or (b) modifying non-economic data measure information associated with an occupational title that already exists in the collection of occupational information. On the other hand, ONET discloses including occupational

⁴ Examiner Notes: As stated within paragraph [0028], lines 10-16; wherein "the survey presents a list of

titles and data measures for each of the occupational titles in the collection (pages 13-15 and 56-76, ONET) and wherein the updating includes either (a) adding a new occupational title and associated non-economic data measure information to the collection of occupational information or (b) modifying non-economic data measure information associated with an occupational title that already exists in the collection of occupational information (pages 48-55, ONET). Pullen, Kauderer, and ONET are analogous art because they are from the same field of endeavor of supplying occupational information. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate ONET's teachings into the Pullen and Kauderer system. A skilled artisan would have been motivated to combine in order to provide the user with information, which was more detailed and self-related to what the user desired and capable of performing.

Regarding Claim 10, the combination of Pullen in view of Kauderer, and further in view of ONET, disclose in a computer system, a method for maintaining a collection of occupational information including descriptions of specific occupations, the method comprising:

providing end users with access to the collection of occupational information ([0030], lines 1-13, Pullen), including providing access to a questionnaire for receiving input from a user of the collection ([0032], Pullen), wherein the questionnaire is for association with a specified occupation for which information is maintained in the

tasks performed by the employee and requests the employee to assign a rank to each of the tasks.

collection of occupational information ([0033], lines 1-6, Pullen)⁵, wherein the questionnaire is a structured analysis questionnaire configured to obtain non-economic worker measure information for the specified occupation, and wherein the questionnaire is not configured for specifying job opening information (pages 48-55, ONET);

receiving the questionnaire from the end user ([0032], Pullen);

analyzing the information in the received questionnaire ([0035], lines 1-8, Pullen);

providing the user with results of the analysis of the questionnaire ([0068], lines 1-5, Kauderer); and

updating the collection of occupational information to include information extracted from the questionnaire ([0029], lines 22-24, Kauderer).

Regarding Claim 11, the combination of Pullen in view of Kauderer, and further in view of ONET, disclose the method wherein the questionnaire is a job analysis questionnaire ([0028], lines 7-10, Kauderer).

Regarding Claim 12, the combination of Pullen in view of Kauderer, and further in view of ONET, disclose the method wherein the questionnaire is a job analysis questionnaire and wherein the questionnaire is pregraded to provide default answers for the specified occupation (pages 39-47, ONET).

Therefore, the task list within the survey represents the questionnaire form.

⁵ Examiner Notes: The hospitality industry corresponds to the specified occupation.

Regarding Claim 30, the combination of Pullen in view of Kauderer, and further in view of ONET, disclose the method wherein the modified data measure information includes skill collection information for the associated occupational title (pages 3,7,11-12, and 85, ONET).

Regarding Claim 31, the combination of Pullen in view of Kauderer, and further in view of ONET, disclose the method wherein the modified data measure information includes industry definition information for the associated occupational title (pages 14 and 87, ONET).

Regarding Claim 32, the combination of Pullen in view of Kauderer, and further in view of ONET, disclose the method wherein the modified data measure information includes stress related work measure information for the associated occupational title (pages 36,38,and 86, ONET).

Regarding Claim 33, the combination of Pullen in view of Kauderer, and further in view of ONET, disclose the method wherein the updating includes performing statistical analysis relating to the worker measure information associated with the specified occupation (pages 13 and 56-76, ONET).

Regarding Claim 34, the combination of Pullen in view of Kauderer, and further in view of ONET, disclose the method wherein the questionnaire is a direct analysis

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questionnaire configured so that raw data from the form is in a format that facilitates direct submission to a raw data database associated with the computer system ([0007] and [0031-0033], Pullen).

Regarding Claim 35, the combination of Pullen in view of Kauderer, and further in view of ONET, disclose the method wherein the questionnaire is a job analysis questionnaire that models publicly available work desk papers used by disability determination adjudicators (pages 77-83, ONET).

Response to Arguments

Applicant's arguments with respect to the newly amended claims have been considered but are moot in view of the new ground(s) of rejection.

10. The declaration filed on July 6, 2007 under 37 CFR 1.131 has been considered but is ineffective to overcome the Kauderer reference. Therefore, the 35 USC 103(a), rejection of claims 3,10-12, and 30-35 is maintained.

11. Evidence consists of affidavits, transcripts of depositions, documents, and things. All evidence must be submitted in the form of an exhibit. When the exhibit is paper: (i) Each page must be uniquely numbered in sequence, and (ii) The exhibit label must be affixed to the lower right corner of the first page of the exhibit without obscuring

information on the first page or, if obscuring is unavoidable, affixed to a duplicate first page.

The filed declaration has not been properly executed. In particular, within the declaration the applicant references an attached "Exhibit A" multiple times throughout the declaration, however, the examiner is unable to locate such an exhibit. As a result, Examiner is unsure of the items and facts contained within the Exhibit.

12. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Kauderer reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

It is unclear to the examiner how the claimed subject matter found within the independent claims relate to the description set forth about the Exhibit, when no Exhibit has been received. For example, the examiner is unable to locate "collecting information associated with a collection of occupational information including a collection of occupational titles and data measures for each of the occupational titles in the collection". As such, full support for the limitations within the claims have not been established.

13. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Kauderer reference to either a constructive reduction to practice or an actual reduction to practice.

Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence.

In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958).

What is meant by diligence is brought out in *Christie v. Seybold*, 1893 C.D. 515, 64 O.G. 1650 (6th Cir. 1893). In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that the record must set forth an explanation or excuse for the inactivity; the USPTO or courts will not speculate on possible explanations for delay or inactivity. See *In re Nelson*, 420 F.2d 1079, 164 USPQ 458 (CCPA 1970). Diligence must be judged on the basis of the particular facts in each case. See MPEP § 2138.06 for a detailed discussion of the diligence requirement for proving prior invention.

Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. The "lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon" is not relevant to an affidavit or declaration under 37 CFR 1.131. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947). Form paragraph 7.62 (reproduced in MPEP § 715) may be used to respond to a 37 CFR 1.131 affidavit where diligence is lacking.

Applicant has failed to describe and show how they were diligent in the period from February 24, 2003 until the filing of their provisional application on March 21, 2003.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Points of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chelcie Daye whose telephone number is 571-272-3891. The examiner can normally be reached on M-F, 7:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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August 15, 2007


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